REMARKS

These remarks are made responsive to the first final office action mailed March 15, 2005.

The pending claims are 1-3, 5-9, and 11-14. Claims 1, 7 and 13 have been amended. Reconsideration of these claims for allowance is respectfully requested in view of the following remarks.

Provisional Non-Statutory Double Patenting Rejections

The Examiner provisionally rejected claims 1-3, 5, 6, 13, 14 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-5, 7,8, 15 of copending application no. 09/704,394.

The Examiner provisionally rejected claims 1-3, 5-9, 11 -14 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-14 of copending application no. 09/633,077 in view of Kirsch, U.S. Patent 5,963,915.

A terminal disclaimer to obviate a provisional double patenting rejection over a pending "reference" application form (PTO/SB/25) has been filed for each with respect to each of U.S. patent application no. 09/704,394 and U.S. patent application no. 09/633,077. It is respectfully requested that the provisional non-statutory double patenting rejections be removed with respect to claims 1-3, 5, 6, 13, 14 and claims 1-3, 5-9, 11 -14.

Rejection of Claims 1 and 7 under 35 USC § 112

Claims 1 and 7 were rejected for insufficient antecedent basis with respect to the limitation "the key." In both independent claims 1 and 7, the first instance of "the key" has been replaced with "a key" as indicated to remove the insufficient antecedent basis. Removal of the 35 USC § 112 rejection with respect to claims 1 and 7 is respectfully requested.

Rejection of claims 1-4, 13 under 35 U.S.C. 103(a) as being unpatentable over Tracy, 6,199,753, in view of Kirsch, 5,963,915.

Claims 1-3, 13 as amended are patentable over Tracy, 6,199,753, in view of Kirsch, 5,963,915 under 35 U.S.C. 103(a).

The Examiner's arguments treat the term "location token" as simply "token" without any limitation provided by the term "location." For clarity, claim 1 has been amended to further explicitly recite "a location token for indicating physical presence of a client system close to the physical entity." Additionally, for clarity, claim 1 has been amended to indicate that the content for a client system close to the physical entity is provided "if the customized location token has not expired."

One of ordinary skill in the art would not be motivated by the combination of Tracy in view of Kirsch to make the claimed invention of claim 1. Tracy does deal with portable data terminals; however, Tracey has no need, and therefore lacks motivation for the subject matter of claim 1. Before the portable terminal leaves the dispenser unit and is in the hand of a customer, the server in the store or the server network located outside the store has linked the customer to that terminal, have that customer's data file and the IP address of that terminal. Additionally, before the terminal leaves the dispenser unit, the terminal has the web address of the server. (See Tracy, Figure 9 and columns 6:66 to 7:61.) Thus, there is no disclosure or suggestion of "a location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server and a location token for indicating physical presence of the client system close to the physical entity and which expires within a predetermined time period because there is no need for transmission of a web address of the server to terminals that already have the web address stored. Therefore, at least any one of the following elements of claim 1 are not described or needed in Tracy:

A location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server and a location token <u>for indicating physical presence of the client system close to the physical entity and which</u> ~~that~~ expires within a predetermined time period;

a location authentication module for authenticating that the client system having received the first beacon signal is still close to the physical entity wherein the location authentication module receives a first request including the web address, the location token, and ~~the key~~ <u>a key</u> from the client system;

a location authentication beacon adjacent to the physical entity and communicatively coupled to the location authentication module for receiving the key and

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the location token and for encrypting a customized location token that expires in a predetermined time period using the key and for transmitting a second beacon signal within the predetermined transmission range containing the web address and the customized token; and

responsive to receiving a second request from the client system including the customized token and the web address, the location authentication module causes the web server to provide content designed for an access request from the client system close to the physical entity if the customized location token has not expired.

The Examiner relies on Kirsch to teach any one of the elements of the location authentication beacon adjacent to the physical entity and the location authentication module. Kirsch which deals with a client browser and merchant server performing a purchase transaction over a general access wide area connected network (See abstract). Not only does Kirsch provide no suggestion of a location token for indicating physical presence of the client system close to the physical entity, much less "a location authentication beacon *adjacent to the physical entity.....* " or a "location authentication module [which] causes the web server to provide content designed for an access request from the client system *close to the physical entity if the customized location token has not expired,*" its use of tokens is entirely independent of locations as needs to be in the described multi-vendor transactions of Kirsch. Kirsch deals with the transfer of customer data between multiple vendors so that it appears to the customer that he is purchasing goods from multiple vendors in one transaction over the Internet. (See for example Kirsch 3:41 – 4:51, 9:54-65, 10:47-53). Multiple vendors tend to be in different physical locations, and physical location in an Internet transaction is irrelevant.

In an obviousness argument of two references, the teachings of other elements can come from the other reference and motivation can come from the other reference, or ordinary skill in the art or the combination of references. However, not only do these two references fail to teach or suggest at least one of the elements of claim 1, one of ordinary skill in the art is not going to be motivated by the combination of Tracy in view of Kirsch to make the subject matter of claim 1. Tracy does not need and, therefore, does not disclose at least "a location beacon adjacent to the physical entity..." nor "a location authentication beacon ...." or a "location authentication module." Kirsch is focused on

passing customer account information among multiple sellers. The connection of Tracy which does not need any of these elements because of its set-up to Kirsch for motivation to make any one of the elements of claim 1 such as a *location* beacon *adjacent to the physical entity*, a *location* authentication beacon or a *location* authentication module, is negated because for Kirsch, physical presence of a client system is not only irrelevant but inconsistent with its objective of passing customer account information to a multitude of vendors connected via the Internet to make it all look like one transaction. Claim 1 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch.

Claim 2

Claim 2 depends from claim 1. The arguments with respect to claim 1 are also applicable to claim 2. Furthermore, the combination of Tracy in view of Kirsch fails to disclose teach, suggest to or motivate one of ordinary skill in the art to make "the system of claim 1, wherein responsive to the location token in the first request being expired, the location authentication module causes the web server to provide content designed for an access request from a client system not close to the physical entity." Tracy does not distinguish between content designed for an access request from a client system close to the physical entity and that from a client system not close to the physical entity. Kirsch is not concerned with location at all much less encryption of location tokens have predetermined time periods, the expiration of which are a basis for directing content dependent on the proximity of a client system to a physical entity. Therefore, the combination of Tracy in view of Kirsch does not motivate one of ordinary skill in the art to make the subject matter of claim 2. Claim 2 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch.

Claim 3

Claim 3 is unamended and depends from claim 1 as amended. The arguments with respect to claim 1 are also applicable to claim 3. Claim 3 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch.

Claim 13

Claim 13 has been amended as indicated below:

       .....

       transmitting within a predetermined transmission range a first

beacon signal containing a web address of the web server system and a

location token <u>for indicating physical presence of the client system close</u>

<u>to the physical entity and which</u> ~~that~~ expires within a predetermined time

period from a location beacon adjacent to the physical entity;

       .....

       Claim 13 is patentably distinct under 35 U.S.C. 103(a) over Tracy in view of

Kirsch. The arguments presented with respect to claim 1 are applicable to claim 13 as

well. Therefore, this combination fails to motivate one of ordinary skill in the art to

perform or devise at least transmitting within a predetermined transmission range a first

beacon signal containing a web address of the web server system and a location token <u>for</u>

<u>indicating physical presence of the client system close to the physical entity and which</u>

expires within a predetermined time period from a location beacon adjacent to the

physical entity. Claim 13 is patentable under 35 U.S.C. 103(a) over Tracy in view of

Kirsch.

<u>Claims 5-9, 11-14 were rejected under 35 U.S.C. 103(a) as being unpatentable</u>

<u>over Tracy, U.S. Patent No. 6,199,753, in view of Kirsch, U.S. Patent No. 5,963,915, as</u>

<u>applied to claim 1 above, and further in view of Schneier.</u>

<u>Claim 5</u>

       Claim 5 depends from claim 1. The arguments presented with respect to claim 1

are also applicable to claim 5. Therefore, claim 5 is patentable under 35 U.S.C. 103(a)

over Tracy in view of Kirsch as applied to claim 1 above, and further in view of Schneier.

<u>Claim 6</u>

       Claim 6 depends from claim 1. The arguments presented with respect to claim 1

are also applicable to claim 6. Furthermore, none of the elements which the location

authentication beacon further comprises are disclosed or suggested by the combination of

Tracy, in view of Kirsch as applied to claim 1 above, and further in view of Schneier. One of ordinary skill in the art would not be motivated by the description of the dispensing of the terminals in Tracy and the brief references that confidential customer information should be encrypted in Tracy and Kirsch to make a *location authentication beacon* comprising the elements of claim 6 such as a first token generator, a second token generator, a store that stores the customized token and the web address, and a communication interface as claimed. Therefore, claim 6 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above, and further in view of Schneier.

Claim 7

Claim 7 has been amended as indicated below:

.....

a location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server system and a location token <u>for indicating physical presence of the client system close to the physical entity and which</u> ~~that~~ expires within a predetermined time period;

.....

Claim 7 as amended is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above, and further in view of Schneier. Therefore, this combination fails to motivate one of ordinary skill in the art to perform or devise at least a location beacon adjacent to the physical entity to transmit within a predetermined transmission range a first beacon signal containing a web address of the web server system and a location token <u>for indicating physical presence of the client system close to the physical entity and which</u> ~~that~~ expires within a predetermined time period. Therefore claim 7 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier.

Claim 8

Claim 8 depends from claim 7. The arguments with respect to claim 7 are also applicable to claim 8. Furthermore, claim 8 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier as this combination fails to disclose, teach, suggest to or motivate one of ordinary skill in the art to make "the system of claim 7, wherein responsive to the location token in the first request being expired, the location authentication module causes the web server to provide web content designed for an access request from a client system not close to the physical entity." Tracy does not distinguish between content designed for an access request from a client system not close to the physical entity that for an access request from a client system close to the physical entity. Kirsch is not concerned with location at all, much less encryption of a customized token having predetermined time period whose expiration indicates the proximity of a client device to a physical entity. Schneier's reference to random number generation does not provide the necessary motivation or suggestion for a location authentication system lacking in the other two to the combination. Therefore claim 8 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier.

Claim 9

Claim 9 is unamended and depends from claim 7 as amended. The arguments with respect to claim 7 are also applicable to claim 9. Therefore claim 9 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier.

Claim 11

Claim 11 is unamended and depends from claim 7 as amended. The arguments with respect to claim 7 are also applicable to claim 11. Furthermore, none of these references suggest a beacon receiver, much less any of the elements it comprises as recited in claim 11. Therefore claim 11 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier.

Claim 12

Claim 12 is unamended and depends from claim 7 as amended. The arguments presented with respect to claim 7 are also applicable to claim 12. Furthermore, none of the elements which the location authentication beacon further comprises are disclosed or suggested by the combination of Tracy, in view of Kirsch as applied to claim 1 above, and further in view of Schneier. One of ordinary skill in the art would not be motivated by the description of the dispensing of the terminals in Tracy and the brief references that confidential customer information should be encrypted in Tracy and Kirsch to make a *location authentication beacon* comprising the elements of claim 12 such as a first token generator, a second token generator, a store that stores the customized token and the web address, and a communication interface as claimed. Therefore, claim 12 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 7 above, and further in view of Schneier.

Claim 13

As explained above, claim 13 as amended is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch. Furthermore, the addition of the reference to random number generation in Schneier fails to provide the motivation or suggestion to one of ordinary skill in the art to devise any of the elements of the method of claim 13. Therefore, claim 13 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above, and further in view of Schneier.

Claim 14

Claim 14 depends from claim 13. The arguments presented above for claim 13 are also applicable to claim 14. Furthermore, Tracy does not distinguish between content designed for an access request from a client system close to the physical entity and that for an access request from a client system not close to the physical entity. Kirsch is not concerned with location at all, much less directing content dependent on the proximity of a client terminal to a physical entity based on an expiration of a predetermined time period of an encrypted customized token. Schneier's reference to random number generation does not provide the necessary motivation or suggestion for providing content based on whether a client system is close to a physical entity or not lacking in the other

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two to the combination or from ordinary skill in view of the combination. Therefore claim 14 is patentable under 35 U.S.C. 103(a) over Tracy in view of Kirsch as applied to claim 1 above and further in view of Schneier.

<u>Conclusion</u>

In light of the arguments presented above, pending claims 1-3, 5-9 and 11-14 as amended are in condition for allowance, and applicants respectfully request a prompt notice of allowance.

Date: *June 16, 2005*   Respectfully Submitted on Behalf of Applicants
Deborah L. Caswell, et al

Eileen Lehmann

Eileen Lehmann
Registration No. 39,272
Hewlett-Packard Company
Mail Stop 1197
1501 Page Mill Road
Palo Alto, CA 94304
650-857-7940 (telephone)
650-852-8063 (fax)